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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,658	08/24/2001	Elsa Jolimaître	PET-1949	1667
23599	7500	11-19/2003	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			NGUYEN, TAM M	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,658

Applicant(s)

JOLIMAITRE ET AL.

Examiner

Tam M. Nguyen

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 19-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35,36 and 38 is/are allowed.
- 6) ☒ Claim(s) 1,2,19,25-34,37,39 and 40 is/are rejected.
- 7) ☒ Claim(s) 20-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1. ☒ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 40 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "essentially devoid of linear and mono branched paraffins" was not described in the specification at the time the application was filed. It is reminded that the first effluent **only** essentially devoid of linear and mono branched paraffins when the catalyst is a EU-1 and the catalyst in claim 40 is not a EU-1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 19, 28-34, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Zinnen et al. (5,744,684).

Zinnen discloses a process for separating normal and mono paraffins from multibranched paraffins in a mixture by contacting the mixture with an adsorbent of EU-1 to produce a stream rich in mono branched paraffin, a stream rich in normal paraffin, and a stream rich in multibranched paraffin. The separating step is operated at a temperature from of 100 to 300⁰ C

and at a pressure from of 6 to 500 psig (0.04 to 3 MPa). It is noted that Zinnen does not specifically disclose the characteristics of EU-1 adsorbent. However, the EU-1 adsorbent is the same as the claimed adsorbent. Therefore, the Zinnen adsorbent would have the claimed characteristics. It also noted that Zinnen does not specifically disclose that the first fraction has a high octane and a second fraction has a low octane. However, a first fraction of Zinnen comprises multi-branched paraffins and a second fraction of Zinnen does not contain multibranched paraffins. Therefore, it is reasonable to consider that the first fraction is a high octane fraction and the second fraction is a low octane fraction as claimed. Zinnen also discloses that the second fraction is recycled back to the isomerization zone. See entire patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25-27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zinnen et al. (5,744,684).

Regarding claims 25-27, Zinnen does not specifically disclose the origin of the feed. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Zinnen by using a feed from the claimed sources because the Zinnen feed is similar to claimed feed. Therefore, where the feed comes from does not affect the outcome of the Zinnen process.

Regarding claim 37, Zinnen does not disclose that the feed has paraffin content between 30 and 80 % by weight. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Zinnen by using a feed which contains the claimed amount of paraffins because the adsorption zone of Zinnen is effective to separate multi-branched paraffins from normal paraffins and because components other than paraffins in the feed will not be absorbed in the adsorption zone. Therefore, it would be expected that the results would be similar when using the claimed feed in the process of Zinnen.

Allowable Subject Matter

Claims 35, 36, and 38 are allowed.

Claims 20-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or renders obvious a process of separating multibranched paraffins from a hydrocarbon feed containing 5 to 8 carbon atoms per molecule by contacting the hydrocarbon feed with a zeolite (e.g., NES, MWW, NU-85, NU-86) as called for in claims 20-23 and 35.

Also, no prior art of record discloses or renders obvious a process of separating multibranched paraffins from a hydrocarbon feed containing 5 to 8 carbon atoms per molecule by contacting the hydrocarbon feed with a zeolite (e.g., EUO, NES, MWW, NU-85, NU-86) which is mixed with a zeolite type LTA as called for in claims 24 and 36.

Response to Arguments

The argument that the presence of multibranched paraffins in the first stream of Zinnen does not mean that multibranched paraffins are essential and the rejection is devoid of any explanation as to why one of ordinary skill in the art would be motivated to modify the first fraction of US '684 so that the first stream is a stream consisting essentially of multibranched paraffins is not persuasive. According to the patent law, the transitional phrase "consisting

Art Unit: 1764

essentially of” limits the scope of a claim to the specified materials or steps “and those **that do not materially affect the basic and novel characteristic(s)**” of the claimed invention. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “**comprising**.” See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”). See also *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). The limitation “consisting essentially of multibranched paraffins” is embraced by Zinnen because the Zinnen stream comprises multibranched paraffins as claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Application/Control Number: 09/935,658

Page 7

Art Unit: 1764

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

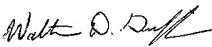
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tam M. Nguyen
Examiner
Art Unit 1764

TN


Walter D. Griffin
Primary Examiner